

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 09/490,500
Filing Date: September 30, 1999
Title: AUDIO ASSISTED SETUP APPARATUS AND METHOD

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REMARKS

The present Amendment adds claims 29-31. As a result, claims 1-31 are now pending in the application.

The Office Action includes i) a rejection of claims 1 and 16 under 35 U.S.C. §102 in view of U.S. Patent 5,815,586 ("Dobbins"); ii) a rejection of claims 4, 22, 23, and 28 under 35 U.S.C. §103 as being unpatentable in view of the Dobbins patent; iii) a rejection of claims 1, 3, 6-14, 16, 18-21, and 23-27 under 35 U.S.C. §103 as being unpatentable over U.S. Patent 5,577,918 ("Crowell"); iv) a rejection of claim 2 under 35 U.S.C. §103 in view of Crowell and further in view of U.S. Patent 4,611,262 ("Galloway"); and v) a rejection of claim 2 under 35 U.S.C. §103 as being unpatentable in view of Crowell in further view of U.S. Patent 5,853,372 ("Britton"). The Office Action also indicates that the drawings are approved, and acknowledges the consideration of the patents submitted as part of the IDS filed on September 30, 1999.

§ 102 Rejection of the Claims in View of Dobbins

The §102 rejection of claims 1 and 16 in view of Dobbins is respectfully traversed.

Both independent claims 1 and 16 recite features that are not disclosed by the Dobbins patent cited in the Office Action. Claim 1 of the present invention teaches using audio file instructions for setting up a computer system. In contrast, the Dobbins patent involves the use of audio instructions only for medication containers. The Field of the Invention from the Dobbins patent states that the Dobbins device "relates generally to medication containers, and deals more particularly with closures for these containers." Furthermore, claim 1 of the Dobbins patent defines the scope of Dobbins' invention as being drawn to "recording verbal patient instructions for the proper use of the medication" (emphasis added). Dobbins' claim 1 indicates the Dobbins patent is specific to medication containers. Consequently, the Dobbins patent does not teach a "memory containing audio file instructions for setting up a computer system" or "wherein the setup apparatus is activated upon a triggering event before the computer system is set up," as recited in claim

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1. The Dobbins patent also does not teach "method of assisting a user in set up of a computer system," as recited in claim 16.

Accordingly, it is respectfully submitted that Dobbins does not teach the features of the claimed invention. Therefore, the applicant earnestly requests withdrawal of the §102 rejection of claims 1 and 16.

Traversal of Inherency

The Office Action contends that a processor is inherently included by the function of a recording in the Dobbins patent, and is inherently included in the receiving and retaining elements in the Crowell patent. Applicant respectfully disagrees with these contentions. To establish inherency, MPEP §2112 requires that the allegedly inherent feature must necessarily be present, and not merely be a possibility:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.¹

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'²

In the present context, it is certainly foreseeable that the function of the recording discussed in the Dobbins patent and the receiving and retaining elements in the Crowell patent may not be configured with a processor in the manner recited in the claims. Such recording, receiving, and retaining can be accomplished without the use of a processor. For example, Recording, receiving, and retaining can be achieved using, magnetic analog technology.

Consequently, it is respectfully submitted that the processor feature is not inherent as described in the Dobbins or Crowell documents. Accordingly, withdrawal of the allegation of inherency is earnestly requested.

¹ MPEP §2112 citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

² MPEP 2112 quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

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§ 103 Rejection of the Claims in View of Dobbins

The §103 rejection of claims 4, 22, 23, and 28 in view of Dobbins is respectfully traversed. The Office Action contends that all features of claims 4, 22, 23 and 28 are disclosed in the Dobbins patent. The applicant respectfully disagrees with this contention.

As discussed above, the Dobbins device specifically pertains to medication containers. As such, Dobbins does not disclose the features of claims 1 and 16, from which claims 4 and 22 depend. Further, Dobbins does not disclose "audio instructions for setting up a computer system," as recited in claim 23, from which claim 28 depends. The Dobbins device is limited to instructions for medication containers. The present invention concerns audio instructions to aid computer setup.

Additionally, the Dobbins device has "a digital display 54 supported by with [sic] the upper surface 22."³ However, Dobbins is silent as to how what information the display is configured to provide. Therefore, Dobbins does not disclose or suggest "a display which displays an instruction number and instruction label for the audio instruction being presented," as recited in claim 4; or "displaying a legend indicating the instruction number and label corresponding to printed instructions," as recited in claim 22 and also in claim 28. Consequently, the pending §103 rejection cannot be properly maintained since, according to MPEP §2143, "the prior art reference [] must teach or suggest all the claim limitations."

Accordingly, it is respectfully submitted that the Dobbins patent does not disclose or suggest the features of the claimed invention. Therefore, withdrawal of the §103 rejection of claims 4, 22, 23 and 28 is respectfully requested.

§ 103 Rejection of the Claims in View of Crowell

The §103 rejection of claims 1, 3, 6-14, 16, 18-21, and 23-27 in view of Dobbins is respectfully traversed.

In order for a claim to be rejected in accordance with C.F.R. § 103, "the prior art

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reference must teach or suggest all the claim limitations.³ The Crowell patent does not teach or suggest all the claim limitations of the present invention. For example, the Crowell patent does not teach "a memory operatively connected to the processor, the memory containing audio file instructions for setting up a computer system." As discussed previously, Crowell does not inherently teach a processor and memory. There is no mention of a processor and memory in the Crowell patent. It discusses receiving and retaining an audio message. Such receiving and retaining can be accomplished by means other than a processor and memory. Therefore, the Crowell patent does not disclose "a memory operatively connected to the processor, the memory containing audio file instructions for setting up a computer system," as recited in claims 3 and 6-8 by virtue of their dependency to claim 1. Furthermore, the Crowell patent does not disclose or suggest audio setup instructions attached to a "container capable of holding computer system components" as recited in claim 9 or "an audio assisted setup apparatus affixed to a component of the computer" as recited in claim 10 and in claims 11-14 by virtue of their dependency to claim 10. The Crowell patent also does not disclose or suggest "assisting a user in set up of a computer system," as recited in claim 16 and in claims 18-21 by virtue of their dependency to claim 16.

Similarly, an examination of the Crowell patent reveals no references to a computer. There is no suggestion in Crowell that the invention be used in conjunction with a computer system or setup of a computer system. Hence, Crowell does not teach "providing a user a set of audio instructions for setting up a computer system," as recited in claim 23 and in claims 24-28 by virtue of their dependency to claim 23.

Accordingly, it is respectfully submitted that the Crowell Patent does not disclose or suggest the features of the claimed invention. Therefore, withdrawal of the §103 rejection in view of Crowell is earnestly requested.

³ Dobbins, col. 4, lines 10-11.

⁴ MPEP 2143

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§ 103 Rejections of the Claims in View of theCrowell/Galloway and Crowell/Britton Hypothetical Combinations

The §103 rejection of claim 2 in view of the Crowell patent and further in view of the Galloway patent is respectfully traversed.

The Office Action acknowledges that Crowell does not teach or suggest a piezoelectric speaker. The Galloway patent is cited because it mentions using a piezoelectric transducer in a greeting card. However, the Galloway patent does not resolve the deficiencies of Crowell, as discussed above in regard to the §102 rejection of claim 1. For example, like Crowell, Galloway does not disclose or suggest a method to use a processor and memory in conjunction with audio instructions to aid a user in the setup of a computer system. Therefore, the hypothetical combination does not teach or suggest "a memory operatively connected to the processor, the memory containing audio file instructions for setting up a computer system" as recited in claim 2 by virtue of its dependency on claim 1. Accordingly, withdrawal of the §103 rejection of claim 2 in view of the Crowell/Galloway hypothetical combination is respectfully requested.

Claims 5, 15 and 17 are rejected in view of the hypothetical combination of Crowell and Britton. Similar to the Crowell/Galloway hypothetical combination discussed above, the addition of the Britton patent does not overcome the deficiencies of Crowell with respect to claims 5, 15 and 17. The Britton patent is relied upon for its discussion of using photo diodes in conjunction with medical equipment. However, the Britton patent does not teach or suggest using the use of audio files to provide instructions for setup of a computer system. Therefore, the deficiencies of the Crowell patent are not resolved by the addition of the secondarily cited Britton patent. Accordingly, withdrawal of the §103 rejection of claims 5, 15 and 17 in view of the Crowell/Britton hypothetical combination is respectfully requested.

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The pending claims are respectfully submitted to be in condition for allowance. Accordingly, notification to that effect is earnestly requested. In the event that issues arise in the application which may readily be resolved via telephone, the Examiner is kindly invited to telephone the Gateway, Inc. attorney at (605)232-1967 to facilitate prosecution of the application.

It is believed that the attached Fee Transmittal attends to the appropriate fees owed for the present Amendment. However, if necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

Date: June 17, 2003

By



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